

REMARKS

Claims 1, 4-6, 9, 11-18 and 20-24 are all the claims pending in the application. Claim 1 has been amended to recite "the average particle diameter of the particulate silver compound is more than 0.08 μm and less than 0.1 μm ". This range is encompassed within the recited ranges found, *inter alia*, in the specification, as filed, at page 12, line 11 and in the Examples, such as in Table 1 bridging pages 18-19. In this regard, the Examiner's attention is directed to the discussion of *In re Wertheim* in the first paragraph of MPEP 2163.05 III., including the discussion in the last three lines of that paragraph concerning a range limitation which met the description requirement. Claim 13 is amended accordingly, and claim 10 is cancelled. Entry is respectfully requested.

The Claims Are Patentable Under 35 USC § 103

Claims 1, 5-6, 9-12, 14-17, and 20-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson Matthey Co. Ltd. et al. (G.B. Pat. 566,718 hereinafter, "G.B. '718") in view of Morrison, Jr. (U.S. Pat. 5,242,623 hereinafter, "U.S. '623").

Claims 1, 4-6, 9-10, 13-18, 20, and 23-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kodas et al. (U.S. Pat. 6,951,666 B2 hereinafter, "Kodas") in view of Morrison, Jr. (U.S. Pat. 5,242,623 hereinafter, "U.S. '623").

The Examiner reasserts the rejections set forth in the previous Office Action mailed August 27, 2008. That is, the Examiner takes the position that the arguments and amendment made to claim 1, submitted in Applicants' response filed November 25, 2008, are unpersuasive.

The Examiner now takes the position that the claimed volume resistivity of the electrically conductive coating would be inherent in the prior art because the composition suggested by the prior art contains similar compounds to those claimed. In support of this position, the Examiner cites the Abstract of Kodas and col. 4, lines 30-40 of U.S. '623, which are alleged to suggest a composition having similar viscosity to that claimed. Therefore, according to the Examiner, those compositions would also be expected to have other properties that are similar to the claimed composition, e.g., the claimed volume resistivity (W) and the claimed specific gravity (X), which would satisfy formula (1) in claim 1.

Applicants respectfully traverse the rejections and amend claim 1.

In claim 1, from which all claims variously depend, the average particle diameter of the particulate silver compound is hereby amended to "more than 0.08 μm and less than 0.1 μm ".

In contrast, with regard to the average particle diameter of the particulate silver compound, G.B. Pat. 566,718 does not disclose any specific range; U.S. Pat. 5,242,623 discloses a range of 0.1 to 10 microns (0.1-10 μm); and U.S. Pat. 6,951,666 B2 discloses a range of at least 0.1 μm and about 10 to 80 nanometers (0.01 to 0.08 μm). Accordingly, no prior art of record discloses the range of the average particle diameter of the particulate silver compound of the present application. Therefore, the present application would not have been obvious over, and is thus patentable over, any combination of the art cited by the Examiner.

Further, Claim 1 recites "the volume resistivity of an electrically conductive coating comprising the electrically conductive paste is about 3.0×10^{-6} to about $8.0 \times 10^{-6} \Omega \cdot \text{cm}$ ". This level of the volume resistivity of an electrically conductive coating is very close to the level of

the volume resistivity of metallic silver, which is $1.6 \times 10^{-6} \Omega \cdot \text{cm}$ (see lines 21 to 22 of page 2 of the specification of the present application).

In contrast, none of the art cited by the Examiner discloses such a volume resistivity, i.e., being very close to the level of the volume resistivity of metallic silver.

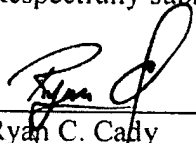
Accordingly, since the present application has a structure that is not disclosed in any of the art of record, and exhibits a volume resistivity that is also not disclosed in any of the art of record, the present application is not obvious.

Withdrawal of the rejections are earnestly solicited.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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